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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,615	12/18/2000	Sheldon Schultz	2003-0001.20	1773
22918	7590	05/03/2006	EXAMINER	
PERKINS COIE LLP			LAM, ANN Y	
P.O. BOX 2168			ART UNIT	
MENLO PARK, CA 94026			PAPER NUMBER	

1641

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/740,615

Applicant(s)

SCHULTZ ET AL.

Examiner

Ann Y. Lam

Art Unit

1641

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 17 March 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 19-26, 28 and 29.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____.


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04/30/06

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments are not persuasive. Applicant argues that the passages cited by Examiner are three relatively short passages taken from different paragraphs and/or different sections of the King reference and that Examiner's hindsight reconstruction connects these teachings. Applicant argues that the King reference at column 4, lines 53-55 simply notes that optical signal is analyzed by a device, e.g., a computer and that there is no disclosure of what optical signal is analyzed (other than the fact that the optical signal consists of light and dark pixels), nor what analysis is carried out on the signal. Applicant also argues that the King reference at column 5, lines 30-34 suggests that the system is simply operated in a mode where the irradiating beam is optimized to a given frequency and intensity at which one, some or all of the pixels of the array are excited. Applicant states that nowhere in the King reference does it show or suggest: comparing a selected spectral characteristic of PREs and other light-scattering entities in the field determined over different wavelengths, and using such comparison to discriminate PREs with a selected spectral signature from other light scattering entities. Applicant also argues that column 5, lines 58-60 of the King reference simply notes that a computer is connected to a detection system for electronically collecting and analyzing the data generated by the detection system. Applicant states that nowhere does this passage indicate what optical signals are analyzed nor what analysis is carried out on the signal. These arguments are not persuasive because the King reference discloses a detection system that detects an array of molecular tags, using a light beam at particular frequency, temporal, and intensity properties to result in the maximum optical signal from the molecular tags, and in such a way that the evanescent field excites one, some or all of the molecules in the array, (col. 5, lines 30-34). The King reference further teaches that a computer is connected to the detection system for electronically collecting and analyzing the data generated by the detection system (col. 5, lines 58-60, and col. 4, lines 53-55). The optical signal being detected, and thus the data collected and analyzed by the computer, is fluorescence (col. 4, line 65, and col. 5, line 23). Moreover, the King reference discloses that the array may have different molecules suitable for binding to different target substances and thus by detecting which of the molecules are excited, the presence of a target substance can be determined (col. 4, lines 66-67). Detecting different molecules in an array by exciting one or some of the molecules using the maximum optical signal is discriminating between the PRE's, at a selected spectral characteristic, i.e., fluorescence wavelength, determined over different spectral wavelengths.